

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUMI AKIYAMA-WARREN

Appeal No. 2001-0224
Application No. 09/045,511

ON BRIEF

Before WILLIAM F. SMITH, TIMM and POTEATE, ***Administrative Patent Judges.***

POTEATE, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 2-11, which are all of the claims remaining in the application.

Claim 2 is representative of the subject matter on appeal and is reproduced below:

2. A meatloaf pan with removable, hinged, pan insert comprising:

a longitudinally elongated, upstanding meatloaf pan of generally rectangular configuration, said meatloaf tray¹ being designed to hold a meatloaf of traditional loaf configuration with side walls, a bottom and top, and pan flanges, which protrude from the top edge of the side walls, extending outward, horizontally, serving as gripping means for the meatloaf pan; and

a pan insert of generally rectangular construction, said pan insert designed to be placed inside of said meatloaf pan during cooking, wherein said pan insert is further comprised of a longitudinally elongated, relatively flat, insert bottom of generally rectangular configuration, dimensioned to fit within said meatloaf pan, having longitudinal edges and an upper surface and a lower surface;

two longitudinally elongated insert side panels, of generally rectangular configuration, having a top edge, said side panels designed to retain the food and also serve as handles, connected entirely along one longitudinal edge to a longitudinal edge of said insert bottom;

hinging means, said hinging means connecting one longitudinal edge of each insert side panel to a longitudinal edge of said pan insert, and extending the entire longitudinal length of said pan insert;

insert flanges, said insert flanges protruding outward from the top edge of each longitudinal insert side panel, and extending longitudinally along the length of said insert side panels, extending outward at a right angle to the plane formed by said insert side panels, with a rounded longitudinal edge;

¹Appellant may wish to amend claim 2 as there is no antecedent basis for this term.

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a plurality of grease holes positioned along the upper surface area of said insert bottom, said grease holes designed to facilitate the runoff of grease from said insert bottom and into the bottom of said meatloaf pan during baking; and

insert stands of cylindrical configuration, extending vertically downward from said lower surface of said insert bottom, near the corners of said insert bottom, said insert stands being designed to maintain a clearance between said insert bottom and any surface said insert bottom is placed on upon removal from said meatloaf pan.

The references relied on by the examiner are:

Eustis	476,137	May 31, 1892
Rozir	1,009,227	Nov. 21, 1911
Clayton	1,272,222	July 9, 1918
Lee	4,106,486	Aug. 15, 1978
Sweitzer	4,334,517	June 15, 1982
Lewin	4,645,090	Feb. 24, 1987
Daenen et al. (Daenen)	D-289,844	May 19, 1987
Vizurraga et al. (Vizurraga)	5,680,803	Oct. 28, 1997

GROUND OF REJECTION

1. Claims 2-3 stand rejected under 35 U.S.C. § 103 as unpatentable over Lee in view of Clayton and Vizurraga;

2. Claims 4-5 stand rejected under 35 U.S.C. § 103 as unpatentable over Lee in view of Clayton, Vizurraga and Daenen;

3. Claim 6 stands rejected under 35 U.S.C. § 103 as unpatentable over Lee in view of Clayton, Vizurraga, and Lewin;

4. Claims 7-8 stand rejected under 35 U.S.C. § 103 as unpatentable over Lee in view of Clayton, Vizurraga, Eustis and Sweitzer; and

5. Claims 9-11 stand rejected under 35 U.S.C. § 103 as unpatentable over Lee in view of Clayton, Vizurraga and Rozir.

We reverse as to all five grounds of rejection.

BACKGROUND

The invention relates to a meatloaf pan with a removable, hinged, pan insert. Appeal Brief, Paper No. 12, received March 21, 2000, page 2, Summary of Invention. The pan insert has a rectangular construction and is designed to be placed inside of a conventional meatloaf pan during cooking. Claim 2. The insert includes two longitudinally elongated side panels, each of which is connected entirely along one longitudinal edge to a longitudinal edge of the insert bottom by a hinging means. **Id.** In addition, insert stands extend vertically downward from the lower surface of the insert bottom to provide clearance between the insert bottom and any surface in which the insert bottom is placed when the insert is removed from

the meatloaf pan. ***Id.***

The above-noted features allow the insert to serve as a cutting board upon removal from the meatloaf pan. Specifically, because the hinging means opens along the longitudinal edge of the device, the meatloaf may be cut perpendicular to the elongated centerline of the meatloaf as is conventionally done, while the meat is still positioned on the insert. Appeal Brief, page 5. Further, the insert stands support the device above a counter. ***Id.***; specification, page 10, line 16 - page 11, line 1. The flanges also serve to separate the insert bottom from the bottom of the meatloaf pan thereby allowing runoff of grease form the insert bottom and into the bottom of the meatloaf pan during baking. Specification, page 10, lines 7-13.

DISCUSSION

The initial burden of presenting a ***prima facie*** case of obviousness rests on the examiner. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). A proper analysis under 35 U.S.C. § 103 requires, ***inter alia***, consideration of two factors: (1) whether the prior art would

have suggested to those of ordinary skill in the art that they should have made the claimed composition or device, or carried out the claimed process; and (2) whether the prior art would have revealed a reasonable expectation of success in so doing. **See In re Dow Chem. Co.**, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. **Id.**

According to the examiner, Lee discloses the invention as claimed with the exception of insert stands attached to the bottom of the insert and hinging along the longitudinal sides of the insert. Final Rejection, Paper No. 7, mailed October 14, 1999, page 2. The examiner relies on Clayton for a disclosure of a cooking device having insert stands and Vizurraga as disclosing a collapsible slicing guide having longitudinal sides with hinges. **Id.** According to the examiner, it would have been obvious to one of ordinary skill in the art to:

(1) incorporate the insert stands of Clayton into Lee's insert since Lee teaches elevating an insert above the bottom surface of an outer pan and the insert stands of Clayton would serve the same purpose; and

(2) incorporate Vizurraga's hinged longitudinal sides into Lee's insert given Lee's teaching of "lowering the end walls in order to cut a food item" and Vizurraga's disclosure that "it is commonly known to cut food items across their width."
Id., pages 2-3.

Based on our review of the entire record, we agree with appellant that the examiner's rejection can only be based upon improper hindsight reasoning.

When the claimed invention combines two or more known elements, "the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." **Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984) (citations omitted). "[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the [] components for combination in the manner claimed." **In re Kotzab**, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). We find that the record is devoid of these "particular findings."

Turning first to the examiner's combination of the Lee and Clayton teachings, we note that Lee discloses that the insert is spaced from the outer pan by seating a ledge extending outwardly from the upper edges of the insert on a flange located on the upper edge of the outer pan. See Lee, column 3, lines 6-11. Lee further notes that the pan cover fits inside the flange in order that condensation on the inside of the cover may flow through the insert and into the pan. *Id.* at lines 16-19. While the examiner may be correct that Lee's insert could be physically modified to include insert stands as taught by Clayton, he has failed to identify any suggestion or motivation to modify Lee to include these stands given Lee's teaching of a complete apparatus which already provides effective means for separating the insert from the bottom of the outer pan.

With respect to the combination of Lee and Vizurraga, we note that the examiner's proposed motivation for combining these references is based on the incorrect statement that "Lee teaches lowering the end walls in order to cut a food item." Contrary to the examiner's contention, Lee teaches that "[t]he ends of the inner pan, when opened, permit the user **to move** the

roast, meat loaf or other items **onto a carving dish** or the like as the case may be." Lee, column 3, lines 39-42 (emphasis added). Thus, Lee's hinged end walls merely facilitate removal of a food item from the pan. Although it might be plausible to include Vizurraga's slicing guide in Lee's device, such modification is simply unsupported by the teachings of the prior art.

In sum, we conclude that the examiner's motivation for combining Lee, Clayton and Vizurraga can only be based upon improper hindsight reasoning. **See W. L. Gore & Assoc. v. Garlock, Inc.**, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.").

The remaining references are relied upon for teachings of the various features recited in dependent claims 4-11. The examiner has not identified how any of these references would cure the above-noted deficiencies in the examiner's proposed

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combination of Lee, Clayton and Vizurraga. Accordingly, we
conclude that the examiner has failed to establish a ***prima facie***
case of obviousness and the rejections are reversed.

REVERSED

WILLIAM F. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CATHERINE TIMM)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LINDA R. POTEATE)	
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LRP:psb

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